REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Status of the claims

Claims 1-22 were previously cancelled. Claim 43 is withdrawn as corresponding to a non-elected invention. Claims 23 and 24 are amended to remove recitation of "preventing." Claim 23 is also amended to insert therein features of the β-amyloid derivative described at page 7, lines 10-17 of the specification. No new matter is added. The foregoing amendments are made solely to advance prosecution and not to acquiesce to any rejection.

Following the foregoing amendments, claims 23-43 are pending, and claims 23-42 are under examination. Claims 23 and 43 are independent.

II. Elections/Restrictions

Applicants acknowledge the Examiner's comments at page 2 of the Office Action regarding the election of species and group and have, accordingly, withdrawn claim 43. Applicants note that the election of species was made solely for the purposes of initial search and examination and respectfully request rejoinder and examination of non-elected species upon the identification of otherwise allowable subject matter in generic/linking claims.

III. Rejections under 35 U.S.C. § 112, first paragraphs

At pages 3-4 of the Office Action it is asserted that claims 23-42 lack written description for the full scope of β-amyloid derivatives. Pages 4-6 of the Office Action assert that claims 23-42 are not enabled for methods of preventing disease. Applicants respectfully traverse but, solely to advance prosecution, have amended claims 23 and 24. Claims 24-42 depend from claim 23 and thereby incorporate its limitations.

The amendments to claims 23 and 24 remove recitation of "preventing." Claim 24 is amended to further defined the β-amyloid derivatives by incorporating elements specifically recited in the specification. Applicants respectfully believe that these amendments overcome

the rejections of claims 23-42 under 35 U.S.C. § 112, first paragraph, and therefore request reconsideration and withdrawal of the rejections.

IV. Rejection under 35 U.S.C. § 102(b)

At pages 6-7 of the Office Action, claims 23, 24, 26, 27, 29, 30, 32, 36, 37 and 39-41 are rejected as allegedly anticipated by U.S. Patent No. 5,750,349 to Suzuki *et al.* ("Suzuki"). Applicants respectfully traverse.

Suzuki discloses and teaches antibodies against specific β-amyloid derivatives, including monoclonal antibodies that the present inventors have found are useful in the presently claimed methods. Suzuki does not disclose that these antibodies are directly useful for the treatment of Alzheimer's and related diseases. Instead, the abstract states that "the antibodies of this invention are useful for the *development* of preventive-therapeutic compositions for Alzheimer's disease." (emphasis added). The development can be performed because the antibodies of Suzuki can determine β-amyloids or the derivatives thereof with high sensitivity. *See* column 22, lines 31-34, and column 40, lines 35-41 of Suzuki. Suzuki also demonstrates that the antibodies are useful as diagnostic products. Suzuki does not, however, highlight particular antibodies that bind to a partial peptide at the C-terminal region of (1) a β-amyloid or (2) a derivative thereof (peptide types (i)-(iv) of the instant claims), and does not bind to a partial peptide having the amino acid sequence represented by SEQ ID NO: 8, for use in a therapeutic method, as presently claimed.

Recently, the Court of Appeals for the Federal Circuit (CAFC) confronted a situation with similar facts in *Impax Laboratories, Inc. v. Aventis Pharmaceuticals Inc.*, 545 F.3d 1312 (Fed. Cir. 2008). The patent-in-suit recited a method of treating ALS with a particular compound. Impax argued that a prior patent anticipated the claim because it disclosed a family of compounds encompassing the claimed compound, it mentioned treating the disease recited in the claim, and it provided general dosage guidelines for treating the disease. However, the CAFC concluded that there was no anticipation because the prior art patent did not highlight the compound of the claimed method, it did not provide working examples from

a model of treating the disease, and the general dosage guidelines did not focus on a particular compound.

In the case at hand, Suzuki similarly does not highlight that antibodies that bind to a partial peptide at the C-terminal region of (1) a β-amyloid or (2) a derivative thereof (peptide types (i)-(iv) of the instant claims), and does not bind to a partial peptide having the amino acid sequence represented by SEQ ID NO: 8, would be suitable for use in the claimed therapeutic methods. Moreover, Suzuki also lacks working examples from any Alzheimer's disease treatment model and does not provide general dosage guidelines for administering the antibodies as a therapeutic. Accordingly, Suzuki does not anticipate the present claims.

CONCLUSION

Applicants respectfully believe that all rejections have been overcome and therefore request rejoinder and examination of non-elected species. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned if it is believed that it would advance prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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